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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,555	01/19/2001	Carlos F. Barbas III	278012001420	1190

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 01/09/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,555

Applicant(s)

BARBAS ET AL

Examiner

Anne R. Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-138 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-138 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 5-31, 36-55 and 133-138, drawn to a method of modulating the expression of a target gene by topically applying a zinc finger protein to a plant, classified in class 514, subclass 2.
- II. Claims 1, 3-31, 36-89, 91-100 and 133-138, drawn to a method of modulating the expression of a target gene by transforming a plant with a nucleic acid that encodes a zinc finger protein, an expression vector, and plant cells, plants and seeds transformed with the vector, classified in class 800, subclass 278.
- III. Claims 1 and 32-35, drawn to a method of modulating the expression of a target gene by providing plant cells with a zinc finger protein linked to a activator or repressor protein, classified in class 514, subclass 2.
- IV. Claims 1, 4 and 64, drawn to a method of modulating the expression of a target gene by transforming a plant organelle with a nucleic acid that encodes a zinc finger protein, classified in class 800, subclass 278.
- V. Claims 90 and 96, drawn to plant cells and seed transformed with a nucleic acid comprising a geminiviral replicase gene operably linked to a fruit-ripening dependent promoter, classified in class 800, subclass 287.
- VI. Claims 101-105, drawn to a zinc finger protein, classified in class 530, subclass 350.
- VII. Claims 106-107, drawn to an antibody that binds to a zinc finger protein, classified in class 530, subclass 387.1.

Art Unit: 1638

- VIII. Claims 108-115, drawn to a nucleic acid encoding a zinc finger protein, cells transformed with the nucleic acid and a method of producing a zinc finger protein, classified in class 536, subclass 23.1.
- IX. Claims 116-117, drawn to a method for determining a suitable position in a gene for regulating gene expression, classified in class 435, subclass 6.
- X. Claims 118-121, drawn to a fusion protein comprising a zinc finger of 2C7 and an effector domain of SID, classified in class 530, subclass 350.
- XI. Claims 122-123, drawn to an antibody to a fusion protein comprising a zinc finger of 2C7 and an effector domain of SID, classified in class 530, subclass 387.1.
- XII. Claims 124-132, drawn to a nucleic acid encoding a fusion protein comprising a zinc finger of 2C7 and an effector domain of SID, cells transformed with the nucleic acid, and a method of producing the fusion protein, classified in class 536, subclass 23.4.

The inventions are distinct, each from the other because:

The methods of Groups I-IV, VIII and IX are independent and distinct inventions, requiring different searches. The different methods have different starting materials, different method steps, and different end products. Additionally, none of the end products of each method are used in any of the other methods.

The plants of Group V are independent and distinct from the methods of Groups I-IV and IX. The plants of Group V are not used in any of the methods.

The proteins of Groups VI, VII, X and XI are independent and distinct from the nucleic acids of Groups VIII and XII. Proteins and nucleic acids differ in composition, structure, and

Art Unit: 1638

function. Additionally, the protein of Group VI may be made by a process other than the expression of the nucleic acid of Group VIII, such as chemical synthesis or purification from the natural source, and the DNA of the second invention may be used for processes other than the production of protein, such as a nucleic acid hybridization assay. Similarly, the protein of Group X may be made by a process other than the expression of the nucleic acid of Group XII, such as chemical synthesis or purification from the natural source, and the DNA of the second invention may be used for processes other than the production of protein, such as a nucleic acid hybridization assay.

The proteins of Groups VI, VII, X and XI and the nucleic acids of Groups VIII and XII are independent and distinct from the plants of Group V. Neither the proteins nor the nucleic acids are used to produce the plants of Group V.

The proteins of Groups VII, X and XI are independent and distinct from the methods of Groups I-IV, VIII and IX. The proteins of Groups VII, X and XI are not used in any of the methods.

The protein of Group VI and the methods of Groups I and III are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case product as claimed can be used in each of the methods of Groups I and III, and can be used to produce an antibody.

The protein of Group VI is independent and distinct from the methods of Groups II, IV, VIII and IX. The protein of Group VI is not used in any of the methods.

Art Unit: 1638

The nucleic acid of Group XII is independent and distinct from the methods of Groups I-IV and IX. The nucleic acid of Group XII is not used in any of the methods.

The nucleic acids of Groups VIII and XII are independent and distinct from each other, as are the proteins of Groups VII, X and XI are independent and distinct from each other.

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds, as are different proteins structurally distinct chemical compounds. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Each sequence requires an independent search of the sequence databases. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and/or classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1638

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.

January 7, 2003

A handwritten signature in cursive script, appearing to read "Amy Nelson".

AMY J. NELSON, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600